RECORD AND BRIEFS

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No. 16-712

In the Supreme Court of the United States

OIL STATES ENERGY SERVICES, LLC

Petitioner,

v.

GREENE'S ENERGY GROUP, LLC, ET AL.

Respondents.

On Writ of Certiorari to the United States Court of Appeals for the Federal Circuit

BRIEF FOR H. TOMÁS GÓMEZ-AROSTEGUI AND SEAN BOTTOMLEY AS *AMICI CURIAE* IN SUPPORT OF NEITHER PARTY

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INTEREST OF *AMICI CURIAE*[1]

This brief is submitted in support of neither party by H. Tomás Gómez-Arostegui and Sean Bottomley. *Amici* are full-time academics who study and write about the history of copyright and patent law in England before the year 1800. *Amici* submit this brief in an effort to ensure that the Court is accurately apprised of relevant historical doctrines.

SUMMARY OF ARGUMENT

This case concerns Section 6 of the Leahy-Smith America Invents Act of 2011, Pub. L. No. 112-29, 35 U.S.C. §§ 311–19. That section created an adversarial administrative process at the United States Patent and Trademark Office in which a person can challenge the novelty or obviousness of a patent after it issues. The question presented is whether this *inter partes* review violates Article III and the Seventh Amendment of the Constitution. The latter inquiry depends, in large part, on the history of English patent law and enforcement circa 1791.

This brief addresses the Seventh Amendment question and, thus, whether validity issues were tried at common law in England. It also corrects re-

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1. No counsel for a party authored this brief in whole or in part. Lewis & Clark Law School paid for the printing and filing of this brief. No other person or entity, or its counsel, made a monetary contribution to the preparation or submission of this brief. The parties have all consented to this filing, and the consents are on file with the Clerk.

cent misconceptions on the subject, including those appearing in an article relied upon by the parties.[2]

Records from the 18th century are unequivocal and demonstrate that juries decided validity questions (including novelty) at several stages of the life of a patent. Juries were tasked with determining validity during infringement litigation, whether initiated at law or in equity; during court proceedings for revoking patents; and sometimes during patent prosecution. For a time, the Privy Council could also revoke patents, but it last did so in 1779.[3]

ARGUMENT

I. Patents of Invention

In the 18th century, the Crown could grant privileges by letters patent for many reasons. Most

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2. Mark A. Lemley, *Why Do Juries Decide if Patents are Valid?*, 99 Virginia L. Rev. 1673 (2013).

3. Some of the case reports relied upon in this brief appear in newspapers and manuscripts. Although this Court has suggested that it prefers "established reports," see *Markman* v. *Westview Instruments, Inc.*, 517 U.S. 370, 380 n.5 (1996), that designation is a misnomer. In the 18th century there were no "established" reports of arguments or trials, and newspaper and manuscript accounts were no less accurate than the nominate reports. James Oldham, *Law Reporting in the London Newspapers, 1756–1786*, 31 Am. J. Legal Hist. 177 (1987); James Oldham, *The Indispensability of Manuscript Case Notes to Eighteenth-Century Barristers and Judges*, in *Making Legal History* 30, 38–52 (Anthony Musson & Chantal Stebbings eds., 2012).

Copies of the principal manuscripts cited herein may be found at www.oldcopyrightcases.org.

pertinent here are patents for invention. The right of the King to grant exclusive rights to inventors was already long standing by the 18th century. As a prerogative function of the Crown, it was derived from and constrained by the common law.[4] The Statute of Monopolies, enacted on May 29, 1624,[5] did not create patents of invention nor did it create a statutory cause of action for patent infringement. Rather, it was declaratory of the common law and further constrained the Crown's ability to issue patents. Patents of invention could issue for no more than 14 years and only to the "first and true inventor" of a "new manufacture" within the realm. Patents were also not to be "hurt[ful] of Trade, or generallie inconvenient."[6]

A. Application Process

The process for issuing patents entailed many administrative steps. By the middle of the 18th century, none were likely to be substantive unless a third party had filed a "caveat" before or while a patent was pending.[7] A common caveat, for example, obligated the Attorney General to inform the third party of patent applications in the field stated

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4. W.M. Hindmarch, *A Treatise on the Law Relating to Patent Privileges* 5, 7–18 (1846).

5. Statute, 1624, 21 Jac. 1, c. 3; 3 *H.L. Journal* 425 (May 29, 1624).

6. 21 Jac. 1, c. 3, § 6.

7. Sean Bottomley, *The British Patent System During the Industrial Revolution 1700–1852*, at 35–39, 53–55 (2014).

in the caveat. This could lead to an opposition in which the Attorney General reviewed the application on the merits. If the opposer did not prevail, he could apply to the Lord Chancellor—who was the keeper of the Great Seal—to block the patent.

Notably, if a person objected to an application on the ground the invention was not new, the Chancellor could direct an issue to a court of common law to have the novelty tested by a jury. Describing one instance of this process in the late 18th century, counsel stated: "[During Joseph Bramah's application], Lord [Chancellor] Thurlow inspected both the old & new [*i.e.*, proposed] Patents & directed an issue to try whether [it was] new or not."[8]

Another example can be found in 1778. A glassmaker, George Ensell, had passed through several stages of a patent application for glass used to glaze prints,[9] but Thomas Quintin, another glassmaker, had objected. The Lord Chancellor referred the novelty of the invention to the Court of King's Bench to be tried by a jury before Lord Mansfield.[10] Although the outcome is not recorded in Mansfield's trial notes, Ensell's patent never issued.

It is unclear how often this type of referral occurred or if any circumstances required it. Never-

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8. Ex parte *Wright*, LI Misc MS 116, p. 80 (Ch. 1793).

9. Warrant for a Patent to George Ensell, SP44/383, pp. 104–05 (Jan. 21, 1777).

10. *Ensell* v. *Quintin* (K.B. 1778), in 1 James Oldham, *The Mansfield Manuscripts* 757–58 (1992).

theless, its presence in the historical record is not surprising given how jury-dependent patent law was in other contexts, as will be explained below.

B. Patent Issuance

In the final stages of a successful application, the patent was engrossed on parchment and taken to the Lord Chancellor to be "sealed" by attaching an impression of the Great Seal to it. It was then delivered to the patentee. The Chancery also kept an official copy or "enrollment" in its own records.

C. Specification (*i.e.*, Description)

By 1734, a standard term in patents required the patentee to submit a specification of the invention after the patent issued.[11] Failure to do so voided the patent. The particularity of specifications varied depending on the complexity of the invention and the inclination and risk aversion of the person submitting it. Many specifications were elaborate, some included drawings, and others were brief.[12]

II. Infringement Litigation

The owner of a patent, aggrieved by an infringement, had several options when choosing a forum for litigation. First, a plaintiff could file a suit on the equity sides of the Court of Chancery or Court of Exchequer. But if the defendant put the

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11. Bottomley (n 7) 46–48.

12. See, *e.g.*, 1–2 *The Repertory of Arts and Manufactures* (1794–1795) (reproducing 41 specifications).

validity of the patent in issue, which was the usual course, the case would have to be referred to one of the law courts in Westminster Hall. Second, a plaintiff could file an action at law in the first instance in the King's Bench, Common Pleas, or Exchequer of Pleas (the law side of the Exchequer).

Either way, the validity of a patent (if contested) was always decided at law, regardless of where the plaintiff initially filed. Moreover, the law courts would always try the case before a jury unless the parties had stipulated to the facts on a referral or had descended the pleadings to an issue of law, neither of which was common in invention lawsuits.

A. Court of Chancery[13]

By the Restoration in 1660, patent owners were filing suits in the Court of Chancery for infringement of their invention patents.[14] The chief reason to file in Chancery was to obtain injunctive relief and a disgorgement of the defendant's profits. The court could grant injunctions "until answer"; injunctions until the "hearing" of the cause, *i.e.*, the bench trial in Chancery; injunctions until a trial or

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13. Because the Chancery was the principal equity court in England and heard more patent suits than the equity side of the Exchequer, this section focuses on the former.

14. Sean Bottomley, *Patent Cases in the Court of Chancery, 1714–58*, 35 J. Legal Hist. 27, 36–37 (2014).

other adjudication of the cause at law; and "perpetual" injunctions at the conclusion of the case.[15]

i. *The Chancery was Obligated to Refer Validity Issues to Law*

As a general matter, the Chancery could sometimes adjudicate suits without having to refer the case to law. But invention suits were special, and the court's ability to adjudicate them fully was limited. This restriction stemmed in part from the Statute of Monopolies, which required the validity of invention patents to be tried and determined according to the common laws of the realm:

> And be it further declared and enacted ... |t|hat all Monopolies and ... lettres patentes ... and the force and validitie of them and every of them ought to be, and shalbe for ever hereafter examyned heard tryed and determined by and accordinge to the Common Lawes of this Realme & not otherwise.[16]

Edward Coke explained that this provision was designed in part to prevent the Chancery from ex-

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15. H. Tomás Gómez-Arostegui, *Equitable Infringement Remedies before 1800*, in *Research Handbook on the History of Copyright Law* 195 (Isabella Alexander & H. Tomás Gómez-Arostegui eds., 2016); Bottomley (n 14) 37–41.

16. 21 Jac. 1, c. 3, § 2. It was previously understood that grants were reviewable at law. Jacob I. Corré, *The Argument, Decision, and Reports of* Darcy v. Allen, 45 Emory L.J. 1261, 1297 (1996).

amining patents.[17] As will be explained below, this meant that if a defendant challenged the validity of an invention, the Chancery was obligated to refer the case to the King's Bench or Common Pleas. In the meantime, while awaiting the result at law, the Chancery would typically enjoin the defendant.[18]

ii. *Manner of Referral*

There were several ways in which the Chancery could send a case to law. If the disputed issue was strictly legal, the court could send the case on a stipulated statement of facts, known as a "case stated," to have all the judges of the King's Bench or Common Pleas decide the legal question. The Chancery could achieve a similar result by ordering the parties to file an action in the King's Bench or Common Pleas and to descend their pleadings to an issue of law via a demurrer.[19] But neither process appears to have been much used in invention cases. No cases in the nominate reports used these procedures before 1800, nor have *amici* discovered any unreported cases utilizing them. This is likely due

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17. Edward Coke, *The Third Part of the Institutes* 182–83 (1644).

18. The Federal Circuit's Seventh Amendment jurisprudence has consistently overlooked these principles. *E.g.*, In re *Lockwood*, 50 F.3d 966, 976 (Fed. Cir. 1995); *Tegal Corp.* v. *Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1339–41 (Fed. Cir. 2001); *AIA Am., Inc.* v. *Avid Radiopharm.*, – F.3d –, 2017 WL 3427755, at *3 (Fed. Cir. Aug. 10, 2017).

19. Gómez-Arostegui (n 15) 211–12.

to the number of factual issues that commonly attended the validity of inventions.

If the parties in Chancery pleaded a factual dispute, the court could take two approaches to send it to law. The first was to direct a "feigned issue." Not cast as an infringement action, the parties would instead draft pleadings at law alleging that a fictional wager of £5 had been made between them over whether the fact in issue existed or not.[20] The jury would try the issue and the law court would report the verdict to Chancery. Often called "directing an issue," this procedure was most useful when there was a narrow issue to be tested. *Amici* have not seen it used in an infringement suit before 1800.

The second and apparently universal method was to direct the plaintiff to file an action at law for infringement. The direction was usually framed as giving the plaintiff "liberty" to file, though that term is misleading. Failure to try the action within a certain amount of time, often designated as 12 months, would lead to the Chancery dismissing the suit in its own court.[21] The action at law would be brought for trespass on the case, and in order to raise the issues of fact, the defendant would plead "not guilty." This general denial placed upon the jury the responsibility to resolve all contested facts. It was also possible for the King's Bench or Com-

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20. 3 William Blackstone, *Commentaries on the Laws of England* 452 (1768).

21. Gómez-Arostegui (n 15) 213; Bottomley (n 14) 40–41.

mon Pleas to address any legal issues raised by the case, whether anticipated or not by the Chancery.[22]

An early instance of directing an action in an invention suit occurs in 1693, when Lord Keeper Somers sent a plaintiff to law after the defendant noted that the common law and Statute of Monopolies required the validity of a patent to be tried at law.[23] The proceeding was later described as follows:

> [A] tryall at Law was directed by this honorable Court to try the vallidity of the said Letters patents which tryall was had accordingly in his Majestys Court of Common Pleas at Westminster ... [on Nov. 29, 1693] when a verdict was given for [the plaintiff] ... against the [defendant] ... in affirmance of the said Letters patents ....[24]

The rule remained the same as one approaches our period of inquiry.[25] In *Newsham* v. *Gray*, for example, the court ordered that the plaintiff was "at liberty to bring an Action" at law so that the novelty of an invention could be tested.[26] And in

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22. Gómez-Arostegui (n 15) 212–13.

23. *Dwight* v. *Chandler*, C5/107/13, C33/279, f. 1013^{v} (Ch. 1693).

24. *Dwight* v. *Talbot*, C8/538/23 (Ch. 1695).

25. Bottomley (n 14) 39–40.

26. C33/376, f. 336^{r-v} (Ch. 1740), 2 Atk. 286, 286–87 (Ch. 1742).

Kay v. *Mills*, the Chancery ordered that the plaintiffs were "at liberty to bring an action ... against any one or more of the Defendants" to test the validity of the patent, and that any defendants not named in the action were, by their consent, to also be "bound by the Event of the Tryall of such Action ... as to the Validity of the said letters Patent."[27]

The equity side of the Court of Exchequer took the same approach. In *Stanyforth* v. *Steel*,[28] the plaintiff held a patent for making plows and sought a perpetual injunction and compensation from the infringer. The defendant questioned the novelty of the invention and insisted that the "Legality of the patent should be tried at Law before a perpetual Injunction ought to be granted."[29] Citing the Statute of Monopolies, Baron Abney agreed and stated that the court would retain the bill for 12 months "with Liberty for the plaintiff to proceed at Law."[30] He also stated he would "never Establish any Monopolies without the [clearest] Proof ... that it was a new Invention, till the patent had the Sanction of a Jury."[31] The other Barons concurred.

The procedure was also reported in 1780, in the case of *Liardet* v. *Johnson*, which involved a patent

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27. C33/387, ff. 697^{v} 698^{v} (Ch. 1747).

28. LL Parker MS, Legal Cases 1740–1744, p. 59 (Exch. 1741/2).

29. *Id.*

30. *Id.* at 60.

31. *Id.*

for stucco cement. Baron Eyre of the Court of Exchequer, who was sitting in place of the Lord Chancellor in Chancery, said the following about the course of procedure in invention suits:

> The ordinary relief in Case of Rights upon Patents is [an] Injunction & an Account. [They] Seldom refuse [to grant an] Injunction till [the] hearing. If [a] Question arises whether there is Infringement or Novelty of Invention, they refer those Questions to Law.[32]

The obligation to send validity issues to law persisted through the turn of the century.[33]

iii. *Trials at Law Bound the Chancery*

Once a case was decided at law, it would return to the Chancery. Typically, the parties would set the cause down for a "hearing" on the "equity reserved,"[34] at which point a dismissal, perpetual injunction, accounting, or taxation of costs might transpire, depending on the outcome of the legal proceeding. Importantly, the result of a jury trial bound the Lord Chancellor; it was not an "advisory"

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32. *Liardet* v. *Johnson*, GT Eldon MS, Notes of Cases 1779, pp. 34, 46 (Ch. 1780) (granting a perpetual injunction after previously sending the case to law via an action).

33. *E.g.*, *Boulton* v. *Bull*, 3 Ves. Jr. 140, 140–41 (Ch. 1796); Robert R. Rankin, *An Analysis of the Law of Patents* 105 (1824).

34. Gómez-Arostegui (n 15) 210–11.

verdict as one scholar contends.[35] As Blackstone noted in 1768, the "verdict of the jurors at law determines the fact in the court of equity."[36] In a patent case, for instance, Baron Eyre (while sitting in for the Lord Chancellor) stated that even if he had a doubt about a verdict, it "does not become me in a Court of Equity on a doubt of mine to impeach it, I am not the proper Judge of the question."[37] This comported with the notion that patents were to be determined by the course of the common law.

Under some circumstances, a new trial could be ordered but this would simply send the case to be tried by another jury. Additionally, the Lord Chancellor could only grant a new trial if the Chancery had sent the case to law by directing an issue. If the Chancery had directed the plaintiff to file an action at law, which was the usual course in invention cases, then only the court that tried the case—either the King's Bench or Common Pleas—had the power to order a new trial. Consequently, if

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35. Lemley (n 2) 1678 n.17 (citing authorities that do not support the proposition).

36. 3 Blackstone (n 20) 452.

37. *Liardet* v. *Johnson*, 1 Y. & C. Ch. Cas. 527, 533 (Ch. 1780); see also *Liardet*, GT Eldon MS, pp. 47–48 ("This is Evidence attacking the very point of the Verdict. I [might] ... have very great difficulty in conceiving how this Verdict was obtained but I am not authorised to entertain doubts ....").

the judges in that court were satisfied with the verdict, the result from that court would govern.[38]

B. Courts of King's Bench, Common Pleas, and Exchequer of Pleas

A patent owner filing an action at law at the insistence of an equity court or in the first instance could proceed in either the King's Bench, Common Pleas, or Exchequer of Pleas. If the pleadings culminated in a demurrer, thereby putting only a legal issue in play, then the bar of the court, *i.e.*, all four judges of the court, would rule on the demurrer without the need to call a jury. Unlike today, demurrers on the merits conclusively admitted the allegations made by the other side. Thus, while the grant of a defendant's demurrer would lead to a judgment for the defendant, denial of the demurrer would lead to a judgment for the plaintiff.[39] If the defendant pleaded "not guilty" and thereby asked that the case be heard by "the country," then a *venire facias* would issue for a trial by jury.[40]

i. *Juries Decided Validity Issues*

Numerous infringement actions were filed in the late 18th century, many more than the nominate

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38. *Liardet*, GT Eldon MS, p. 34; *Fowkes* v. *Chadd*, 2 Dick. 576, 576–77 (Ch. 1780); Ex parte *Kensington*, Coop. G. 96, 96–97 (Ch. 1815); *Bootle* v. *Blundell*, Coop. G. 136, 137 (Ch. 1815).

39. 3 Richard Wooddeson, *A Systematical View of the Laws of England* 73–74, 76 (1793).

40. 3 Blackstone (n 20) 352.

reports reveal. Although no attempt was made to trace them all for purposes of this brief, *amici* have reviewed 42 cases heard between 1763 and 1800. The parties obtained a jury trial in all of them and the validity of the patent was contested in nearly all. That the cases went to trial is not surprising, given that it was rare, as a general matter, for litigants to descend their pleadings to a demurrer.[41]

The cases were all tried at *nisi prius* and appear to have all returned general (rather than special) verdicts, except in cases where a nonsuit was granted. Most were tried in the King's Bench with a special jury. Special juries differed from ordinary ones in that they were supposed to be composed of merchants, tradesmen, and gentlemen.[42] This did not mean, however, that the jurors were experts in the technology in suit. Indeed, the method of jury selection made the impaneling of true experts difficult.[43] Thus, the only relevant expertise one could count on came from witnesses in the case. It

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41. James Oldham, *Trial by Jury* 10 & n.28 (2006).

42. It is incorrect to say that special juries were comprised "entirely of lords and gentlemen, rather than commoners." Lemley (n 2) 1685 n.51. Lords were exempt from jury service, *The Complete Juryman* 37, 115 (1752), and many juries were comprised exclusively of merchants.

43. See James Oldham, *English Common Law in the Age of Mansfield* 22–25 (2004). In 1829, several witnesses in Parliament lamented that juries (including special ones) often did not understand the technologies at issue. *Report from the Select Committee on the Law Relative to Patents for Inventions* 14–16, 40, 45–47, 91, 101, 128–29 (1829).

was also common for some special jurors to not appear, thereby requiring ordinary jurors to sit in their place.[44] Thus, in the end, some special juries were actually made up in part of ordinary jurors.[45]

The cases demonstrate that juries regularly decided the following issues related to validity:

(1) whether the invention was new;

(2) whether the patentee was the actual inventor of the purported invention;

(3) whether the invention was useful;

(4) whether the specification accurately described the claimed invention; and

(5) whether the specification enabled a person working in the relevant art to construct the item described in it.

Juries heard an assortment of evidence to assist them in their deliberations. They were shown the patent and its specification, and they reviewed mechanical models, trade recipes, books, dictionaries, and prior specifications. Naturally, they also heard testimony from persons working in the relevant trade or who otherwise had relevant expertise.[46]

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44. See *Robinson* v. *Wheble* (K.B. 1771), in 2 *The Lady's Magazine* 41 n.* (1771).

45. *E.g.*, *Rex* v. *Arkwright* (K.B. 1785), in *The Trial of a Cause Instituted by Richard Pepper Arden* &c 11 (1785).

46. *E.g.*, *Liardet* v. *Johnson* (K.B. 1778), in *Public Advertiser*, Feb. 23, 1778, p. 3; 1 Oldham (n 10) 748, 749–51.

Importantly, the aforementioned issues were all considered issues of fact, which by the common law were within the province of the jury. In 1778, for instance, Lord Mansfield instructed the jury that whether the plaintiff's "cement was known and in use before" was "a matter of fact, the proof of which lies on Defendant."[47] And after granting a new trial in the same case, he instructed the second jury similarly. According to Justice Buller, who took notes of the trial, Lord Mansfield proceeded as follows:

> [He] left to the jury 1st, on all objections made to exactness, certainty and propriety of the Specification, & whether any workman could make it by [the Specification].... [and] 2d, whether [it was] an invention of Plaintiff, whether publicly used by others before.[48]

Lord Loughborough similarly instructed a jury that the "Patentee must be really the Inventor, that the Invention must be new, and the specification so described, as to enable ingenious mechanics to

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47. *Liardet*, in 1 Oldham (n 10) 753.

48. *Liardet* v. *Johnson* (K.B. 1778) (2d trial), in *id.* at 756. Lord Mansfield's remarks were also taken down by a shorthand writer who wrote that he charged the jury with finding three things to their "satisfaction": infringement, novelty, and enablement. *A Reply to Observations on Two Trials at Law* 23 24, 38 (1778).

make the machine."[49] Justice Buller instructed his juries that it was for them to decide whether the invention was new; if so, whether the patentee invented it; and whether the specification sufficiently described it.[50] Likewise, Justice Rooke stated that whether a "mechanical improvement is intelligibly specified" is something on "which a jury must be the judges."[51] Justice Lawrence said that whether the directions in a specification "were or were not sufficient is not now a question for our decision; it was a question for the determination of the jury, and they have decided it."[52] And Lord Eldon was of the same view, stating that enablement was "a matter of fact which ought to be left solely to a Jury to determine"[53] and that "the utility of the discovery, the intelligibility of the description, &c., are all of them matters of fact, proper for a jury."[54]

As one would expect, there were matters relating to validity that courts considered questions of law during and immediately after trials. For example, courts ruled that:

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49. *Strutt* v. *James* (C.P. 1783), in *London Chronicle*, July 22, 1783, pp. 74, 75.

50. *Arkwright*, in *Trial* (n 45) 172, 182, 187.

51. *Boulton* v. *Bull*, 2 H. Bl. 463, 479 (C.P. 1795).

52. *Hornblower* v. *Boulton*, 8 T.R. 95, 108 (K.B. 1799).

53. *Cartwright* v. *Aymett* (C.P. 1800), in *Lloyd's Evening Post*, May 9, 1800, pp. 444–45.

54. *Hill* v. *Thompson*, 3 Meriv. 622, 630 (Ch. 1817).

(1) an invention was still new even if previously known in a foreign country;[55]

(2) an improvement to the prior art could be patented;[56]

(3) a patent for an improvement over the prior art was invalid if the specification claimed the prior art as well;[57] and

(4) an invention was not enabled if a person in the field had to exercise "invention" to make what was listed in the specification.[58]

These were legal principles applicable to future cases.

ii. *Most Validity Issues Were Not Mixed Questions of Fact and Law*

In a recent article, Professor Lemley argues that an ultimate or overarching issue of validity existed in the late 18th century that was "not itself a question of fact,"[59] but was instead a question of law. He contends that this ultimate issue was separate from the novelty, inventorship, utility, and disclosure issues decided by juries. In other words, juries found facts on those issues, but it was still always

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55. *Calthorp* v. *Waymans*, 3 Keble 710, 710 (K.B. 1676).

56. *Morris* v. *Braunson*, IT Misc MS 96, pp. 80, 80 (K.B. 1776).

57. *Rex* v. *Else*, *cit.* 11 East 109 n.(*c*) (K.B. 1785).

58. *Arkwright*, in *Trial* (n 45) 172–73.

59. Lemley (n 2) 1688.

left to the judge to make a separate "normative" judgment, based on the facts of each case, on whether the patent was invalid.[60] Given the significance of this assertion, and the fact the Respondent has already relied upon it,[61] it requires close inspection. In short, Lemley is incorrect and he cites no authorities that support the proposition.

First, the House of Lords did not affirm in a "number" of decisions before 1791 that the validity of an invention was an issue of law, as his article suggests.[62] The single House of Lords case cited for this proposition dealt with a patent for a market. On a *scire facias* to repeal it, the Crown alleged that the patent was deceitfully obtained and damaged a nearby market. The patentee demurred. Both the Court of Chancery in the first instance and the House of Lords on a writ of error concurred that the patentee, by demurring, had confessed the aforesaid allegations and thus judgment repealing the patent was appropriate as a matter of law.[63]

Lemley also cites two invention cases. The first, *Hill* v. *Thompson*, does not broadly state that patent validity was a question of law. Lord Eldon

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60. *Id.* at 1690.

61. Br. in Opp. 11.

62. Lemley (n 2) 1688 & n.58.

63. *Rex* v. *Butler*, 2 Ventr. 344, 344, Freeman 50, 50 (Ch. P.B. 1679/80), 3 Lev. 220, 221–23 (H.L. 1685). None of the other cases cited in Lemley's footnote 60 supports his proposition. None deal with inventions, no others are from the House of Lords, and some were decided in 1820 and 1853.

simply stated that it was for the judge to decide, as a matter of law, whether a specification for an improvement over the prior art claimed, in addition to the improvement, the prior art itself.[64] Thus, in cases where there was potential overreach, violating the third rule identified above (p. 19), the specification became a mixed question of fact and law.

Also misplaced is Lemley's reliance on *Rex* v. *Arkwright*, an action brought on a writ of *scire facias* to revoke an invention patent. He states:

> [T]he court said in *Arkwright*, [that] the question of whether a patent was "contrary to the law, and mischievous to the state, and therefore void ... was merely a consequential one; it stated no fact which could be tried by a jury."[65]

This statement is misleading because the quote does not originate from *Arkwright*. It instead comes from a treatise.[66] The ellipsis also obscures that the quotation stems from the treatise writer's treatment of two separate cases. The first part comes from a discussion of *Darcy* v. *Allen*[67] and the second from a discussion of *Arkwright*. Notably, the treatise does not combine the two, as Lemley does, and

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64. *Hill*, 3 Meriv. at 630.

65. Lemley (n 2) 1688 & n.58.

66. John D. Collier, *An Essay on the Law of Patents* 124 (2d ed. 1803).

67. 11 Co. Rep. 84b, Moore 671 (K.B. 1603).

thus it never states that invalidity, as an ultimate matter, was always a question of law for the judge.

In truth, the judge who presided in *Arkwright*, Justice Buller, merely stated that there was nothing for the jury to try, at least on the record as it existed before him, on *one* potential ground for revoking and cancelling the patent—*viz.*, that the patent was "prejudicial and inconvenient" to the subjects of the realm. He refused to hear any evidence on that issue because it had not been pleaded properly. Unlike other validity issues, which could be pleaded without supporting facts, he thought the inconvenience standard was so general that the prosecutor should plead it with sufficient facts to put the patentee on notice of how to respond. That not having been done, the issue was out of the case. He also noted that if inconvenience had been pleaded properly, it would be for the jury to adjudicate the truth of the facts, and if the facts in the writ were found proven, then it would be up to the judge to decide whether those facts as found met the inconvenience standard as a matter of law.[68]

Importantly, Justice Buller never stated that the other validity grounds at issue in the case—novelty, inventorship, and enablement—were mixed questions of fact and law. He certainly knew

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68. *Rex* v. *Arkwright*, 1 Web. P.C. 64, 64 n.(c), 1 Carp. P.C. 53, 61 (K.B. 1785); *Trial* (n 45) 30–33.

how to express that idea.[69] On the contrary, as we have already noted (p. 18), he left it to the jury to decide those issues. He then did no more than instruct the jury that the patent would be invalid if any one of those issues faltered:

> If you think it is not sufficiently described, that alone puts a complete end to this cause, and then it will be unnecessary to trouble you any further.[70]
>
> [If] you are satisfied none of ... [the parts of the machine] were inventions unknown at the time this patent was granted, or that they were not invented by the defendant: upon either of these points the prosecutor is entitled to your verdict. [¶] If upon any point you are of opinion with the prosecutor, you will find a verdict for him. [¶] If upon all the points you are of opinion for the defendant, you will find a verdict for him.[71]

To be sure, judges could control the jury with various devices, but that was no different in patent cases than in other cases at common law, and it did not turn patent validity into a question of law.

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69. See also *Tindal* v. *Brown*, 1 T.R. 167, 169 (K.B. 1786) (Buller, J.) (stating that "reasonable notice" in the context of bills of exchange was a mixed issue of fact and law).

70. *Arkwright*, 1 Carp. P.C. at 93.

71. *Id.* at 101.

Professor Lemley mentions the ability of judges to direct juries on how to resolve patent cases.[72] It is true that judges would often summarize and comment upon the evidence, and they might direct the jury to focus on certain testimony or documents.[73] Sometimes an instruction went so far as to "direct" the jury to enter a verdict for one party. This instruction might stem from the judge's own view of the weight of the evidence or his ruling on a question of law. In either case, there was nothing special about patents. Besides, jurors had no obligation to follow the directions of the judge on fact issues. In *Bramah* v. *Hardcastle*, for instance, Lord Kenyon told the jury that he thought the invention was not new, and that they should find a verdict for the defendant, but the jury returned a verdict for the plaintiff.[74] Nor did juries technically have a legal obligation to follow instructions on the law.[75]

C. Effect of Validity Determinations

The decision to find a patent valid in the course of infringement litigation did not inoculate the patent. Defendants in subsequent cases remained free to challenge it. Nor did a verdict of invalidity permanently nullify the patent. It was also possible for a

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72. Lemley (n 2) 1690–91.

73. 3 Blackstone (n 20) 375.

74. 1 Carp. P.C. 168, 171–72 (K.B. 1789) (verdict left undisturbed); see also *Eley* v. *Yardley* (K.B. 1790), in *Times*, Dec. 9, 1790, p. 3 ("[T]he Jury contrary to the directions of the Judge, found a verdict for the plaintiff.").

75. Oldham (n 43) 68.

losing patentee to later file suit against another infringer. Nevertheless, a jury's determination was not without consequences. The verdict could affect one's ability to obtain, in a subsequent infringement suit, an interim injunction while the patent was being tested at law again.[76] A verdict could be admitted as evidence in subsequent litigation between the same parties and thereby influence a verdict.[77] And defendants who were not parties to a previous action could raise the patentee's prior loss, particularly with a view to showing reliance on it and mitigating damages.[78] Additionally, for most patentees a loss *de facto* voided the patent,[79] and thus it was sometimes said that a verdict against a patent resulted in it being of "no Force."[80] Only one patentee in the 18th century is known to have sued again after a jury found his patent invalid, and he

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76. See *Hill*, 3 Meriv. at 624–26.

77. *E.g.*, *Morris* v. *Braunson* (K.B. 1776), in 1 Oldham (n 10) 745; *Morning Chronicle*, June 1, 1776, p. 3 ("It appeared in evidence that Bronson had been prosecuted on two former occasions [for patent infringement], when only nominal damages were found against him, and having, in defiance of the law, and every caution, both friendly and hostile, continued his trespass, the jury, in the course of a few moments consideration, found a verdict (which is now the third) for the plaintiff, with 500*l*. damages.").

78. *Arkwright* v. *Nightingale*, 1 Carp. P.C. 38, 44–45, 50 (C.P. 1785).

79. Richard Godson, *A Practical Treatise on the Law of Patents for Invention* 189 (1823).

80. *Arkwright* v. *Mordant* (K.B. 1781), in *Manchester Mercury*, July 24, 1781, p. 4.

was alleged to have colluded with others to ensure a second verdict in his favor.[81]

III. Revocation and Cancellation by Writ of *Scire Facias*

In order to revoke and "cancel" a patent—*i.e.*, to have the sealed patent surrendered and the enrollment struck—one would have to file an action via a writ of *scire facias*. This action was instituted in the Court of Chancery, but contrary to recent scholarship on the subject, and the briefing of the parties on the petition for certiorari, this was not a proceeding that occurred in an "equity court."[82] Nor is it correct to say that revocation claims were "not resolved by juries"[83] or, alternatively, that issues of fact were only "sometimes"[84] delegated to juries.

The Court of Chancery always sat as a law court in these instances and always sent issues of fact related to validity to the King's Bench for a jury trial.

A. The Chancery Sat as a Law Court in Revocation Proceedings

The Court of Chancery had an equity side and a law side. Most of its adjudication occurred on the former, but the law side played an important role in several areas in the late 18th century. Due to a

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81. *Report* (n 43) 184 (Richard Arkwright).
82. Lemley (n 2) 1687; Br. in Opp. 6, 10, 11; Gov't Br. in Opp. 15; Reply Br. 4–5.
83. Br. in Opp. 6; Gov't Br. in Opp. 15.
84. Br. in Opp. 11.

jurisdictional privilege, for example, the servants and officers of the Chancery could not sue or be sued in any other court. Thus, any action at law had to be brought by or against these officials in the Court of Chancery. A limited set of other areas also fell under the common-law jurisdiction of the Chancellor, including, most importantly, the revoking and cancelling of any letters patent (including patents of invention) that were enrolled there.[85]

Although the same person presided over the law and equity courts, those courts were "two distinct tribunals,"[86] and they differed in many respects. The law court had its own staff and its own records, housed in the Petty Bag office, which kept legal pleadings separate from those filed in equity. The pleadings also largely tracked the language and style of those in other law courts, with the exception that they were kept in files, rather than on rolls. And while the law side was a "court of record," as the other law courts were, the equity court was not.[87] But most importantly, when sitting as a law court, the Chancery was with few exceptions to act as one, with the Lord Chancellor "in

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85. H. Tomás Gómez-Arostegui, *The Untold Story of the First Copyright Suit under the Statute of Anne in 1710*, 25 Berkeley Tech. L.J. 1247, 1332–34 (2010).

86. 3 Blackstone (n 20) 47.

87. Gómez-Arostegui (n 85) 1332–36.

his Proceedings and Judgments ... bound to observe the Order and Method of the Common Law."[88]

B. *Scire Facias* Pleadings

During the late 18th century, an action to revoke a patent of invention by writ of *scire facias* would commence when a private party requested the Attorney General for permission to sue out the writ on behalf of the Crown. With the Attorney General's fiat, the writ would then issue, always from the law side of the Chancery to the patentee, and with the writ being made returnable in that court. This was on account of the Chancery possessing the enrollment (*i.e.*, the "record") of the patent.[89]

The writ set out the terms of the patent and its specification, at large in the late 18th century, along with the ways in which the patent, specifica-

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88. 2 William Bohun, *The Practising Attorney and Solicitor* 11 (3d ed. 1732); accord *The Compleat Clerk in Court* 1 (1726) ("Power is limited and confined to the Rules observ'd in the Common Law Courts[.]").

89. Geoffrey Gilbert, *The History and Practice of the High Court of Chancery* 12–13 (1758). The decision in *Attorney General* v. *Vernon*, 1 Vern. 277 (Ch. 1684), which this Court cited in *Mowry* v. *Whitney*, 81 U.S. 434, 440 (1871), is not to the contrary. That case sought to annul a patent in *equity* because the patent at issue, for a grant of land from the Crown, was not in the records of the Chancery. It had been sealed and enrolled by the Chancellor of the Duchy of Lancaster. Thus, a writ of *scire facias* was unavailable. *Attorney General* v. *Vernon*, 1 Vern. 370, 390, 2 Chan. Rep. 353, 357 58 (Ch. 1685/6); 2 Giles Jacob, *The Compleat Chancery-Practiser* 811 (1730).

tion, or both was thought to be deficient. Notably, *scire facias* did not require fraud or inequitable conduct, as the Federal Circuit claims.[90] In *Rex* v. *Singleton*, for example, the writ stated that the Crown had been informed that the grant was

> prejudicial and inconvenient to our Subjects in general[.] And also that the said Invention at the time of granting ... was not a new Invention ... within ... England[.] And further that the same was not invented and found out by the [patentee] .... And moreover [that the specification hath wholly neglected] ... to particularly describe[] and ascertain[] the nature of ... [the] Invention and in what manner the same is to be performed ....[91]

Not all writs claimed prejudice and inconvenience as a ground,[92] and some added other grounds, including that the invention was of "no general Utility"[93] or that it fell outside patentable subject matter.[94] These allegations were all leanly stated.

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90. *Lockwood*, 50 F.3d at 974 n.9; In re *Tech. Licensing Corp.*, 423 F.3d 1286, 1288–91 (Fed. Cir. 2005); Br. in Opp. 11.

91. C217/152 (Ch. P.B. 1796).

92. *E.g.*, *Rex* v. *Else*, C217/152 (Ch. P.B. 1784); *Rex* v. *Argand*, C217/152 (Ch. P.B. 1785).

93. *E.g.*, *Rex* v. *Milward*, C217/152 (Ch. P.B. 1790).

94. *E.g.*, *Rex* v. *Watt*, C217/152 (Ch. P.B. 1795).

The writ would then summon the patentee to appear in the Chancery's law court.

The patentee would appear by his attorney and plead to the allegations. In theory, a patentee could demur, and if this occurred the pleadings would close and the Chancellor would rule on the demurrer as a common-law judge and enter judgment on the record in Chancery.[95] But the odds of a demurrer in invention cases were extremely low because the allegations of the writ closely tracked the requirements of the Statute of Monopolies and of the patent itself. To demur would be to confess that the allegations contained in the writ were true, inevitably leading to the patent being revoked as a matter of law.[96] Thus, *scire facias* actions, like infringement actions, almost invariably led to the patentee (and the prosecutor) pleading that they wished to place themselves "upon the country."[97]

C. Juries Decided Validity Issues

As masters of their own pleadings, when the parties requested a jury trial, the Lord Chancellor was obligated to send the matter to a jury; the course of the common law required it. The Chancery could not summon a jury to appear in its own court, so the Chancery would make up a record of the pleadings and send it to the King's Bench so

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95. Gilbert (n 89) 13.

96. See text to notes 39 & 63 *supra*.

97. *E.g.*, *Rex* v. *Jacob*, C217/162 (Ch. P.B. 1782); *Rex* v. *Arkwright*, C217/162 (Ch. P.B. 1785).

that the cause could be tried there.[98] The King's Bench would try the case in the usual manner with the (oftentimes special) jury addressing issues in the same manner as in an infringement action.

If no new trial was granted by the King's Bench, that court would, according to 18th-century authorities, enter judgment.[99] Actual cancellation of the patent was not always necessary, as the judgment could later be pleaded in bar if the patentee sued on the patent. The patent in *Arkwright*, for example, was not actually struck from the patent rolls.[100]

Following Coke, Professor Lemley argues that the Chancellor was actually responsible for entering judgment, not the King's Bench.[101] From this

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98. 1 Jacob (n 89) 23; Gilbert (n 89) 13; 3 Blackstone (n 20) 48.

99. *E.g.*, Gilbert (n 89) 13; 3 Blackstone (n 20) 48; *Regina* v. *Aires*, 10 Mod. Rep. 258, 260 (K.B. 1714); *Arkwright*, in *Trial* (n 45) 191 (stating that the "*Court of* King's Bench *gave Judgment to* Cancel *the Letters Patent*").

100. Patent of Richard Arkwright, C66/3757, no. 12 (Dec. 16, 1775).

101. Coke did state that the Chancellor entered judgment, see Edward Coke, *The Fourth Part of the Institutes* 80 (1644), as have others relying on him, but treatises questioned that statement, noting that it appeared the "constant practice" was otherwise. 1 Joseph Harrison, *The Accomplish'd Practiser in the High Court of Chancery* 4 n.(*h*) (1741); accord 1 Joseph Harrison & John G. Williams, *The Practice of the Court of Chancery* 7 n.(*d*) (8th ed. 1796); Godson (n 79) 200; Edward Holroyd, *A Practical Treatise of the Law of Patents for Inventions* 187 (1830).

premise Lemley deduces that it was perhaps possible for the Chancellor to ignore the verdict and, after "consideration" of the matter, act according to his own conscience.[102] He goes on to state that it "was the Chancellor, not the jury, who held the final power to revoke a patent using *scire facias*."[103]

Even if it were unclear upon which record a judgment appeared—the King's Bench or Chancery—the deduction is incorrect. The Chancellor, sitting as he was in a law court and thus as a judge bound by the procedures of the common law, had no more right to ignore the jury's verdict than did a judge of the King's Bench. And a jury's finding of fact was not advisory at common law.[104] Respectfully, Lemley's argument mixes the two sides of the court.[105]

After an 1835 statute allowed some defective patents and specifications to be amended, a doubt arose whether the Queen's Bench could enter judgment to cancel a patent, as it would prevent a patentee from utilizing the statutory procedure. The Exchequer Chamber confirmed that the Queen's Bench could enter such a judgment. *Bynner* v. *Regina*, 9 Q.B. 523, 550, 552–53 (Exch. Ch. 1846).

102. Lemley (n 2) 1685; see also *id.* (Chancellor sought "advice" from the jury).

103. *Id.* at 1687.

104. *The Law of Evidence* 3 (3d ed. 1739); 1 Giles Duncombe, *Trials per Pais* 7 (8th ed. 1766).

105. Lemley (n 2) 1685 n.50 (citing sources discussing equity practice and *Bynner* (n 101), which did not state or suggest that the Chancellor in his law court had discretion in the 18th century to act according to his own conscience).

Additionally, the rule in Chancery during the relevant period, at least for personal actions commenced in the Petty Bag, was that if a party was unhappy with a verdict in the King's Bench, their recourse was to seek a new trial from that court; the Chancery could not grant one. Lord Chancellor Thurlow stated:

> [W]hen a record was sent out of this Court on an issue of fact, the King's Bench was to send it back with final judgment upon it; and therefore whatever objection there might be to the verdict should be stated there [in the King's Bench].[106]

IV. Privy Council Proceedings

The Privy Council also played a role in patent law in the 18th century, though that role has been inadvertently overstated by scholars who have relied on nominate reports and neglected manuscript records of the superior courts of England.[107] As a forum to adjudicate infringement, the Council played essentially no role after the Restoration,

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106. Ex parte *Barker*, 1 Cox 418, 418 (Ch. P.B. 1787) (personal action between officers of the court).

107. See, e.g., Edward C. Walterscheid, *Early Evolution of the United States Patent Law*, 77 J. Pat. & Tm. Off. Soc. 771, 773–76 (1995), leading this Court to state incorrectly that "patent litigation had remained within the jurisdiction of the Privy Council until 1752 and hence without the option of a jury trial." *Markman*, 517 U.S. at 381.

with enforcement instead falling to the Chancery, King's Bench, Common Pleas, and Exchequer.[108]

The Council could also revoke patents and in this respect its role was more pronounced. Patents of invention included a defeasance clause permitting six or more Privy Counsellors to declare the patent void if it appeared the invention was contrary to law; prejudicial or inconvenient in general; not new; or not invented by the patentee. A person seeking to revoke a patent would petition the Council, which would refer the matter to a committee, which in turn would delegate the matter to the Attorney General. The Attorney General would examine the petition, consider affidavits from the petitioner and patentee, and hear from counsel.[109] If he favored the petition, the Council would obtain the signature of six or more of its members to void the patent.[110] If the Attorney General found the case wanting, the Council would dismiss it.[111]

From 1700 to 1782, the Council received ten petitions to revoke English patents of invention, and it

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108. Bottomley (n 14) 31–32, 37; H. Tomás Gómez-Arostegui, *Stationers v Seymour (1677)*, in *Landmark Cases in Intellectual Property Law* 21, 38 & n.74 (Jose Bellido ed., 2017).

109. *E.g.*, *Bull* v. *Lydall*, PC2/81, pp. 180–81 (P.C. 1706).

110. *E.g.*, *Darby* v. *Betton*, PC2/99, pp. 358–59 (P.C. 1745/6).

111. *E.g.*, *Baker* v. *James*, PC2/103, pp. 320–21, 346–47 (P.C. 1752).

never received such an application afterward.[112] It revoked four, dismissed two on the merits, and did not resolve the others. The last revocation of an invention patent occurred in 1779, and that was on a matter affecting national security and only after the patentee refused to go to law. The petitioner, the Board of Ordnance, was responsible for supplying munitions to the army and navy during the American Revolutionary War and it sought to annul a patent for casting and boring iron cannons. The patentee had used the patent to impede the Board's contractors.[113] The last English petition, filed with the Council in 1782, and which sought to vacate a patent for pistols, was also referred to the Attorney General, but nothing came of it.[114]

The defeasance clause remained in patents well after 1782, and thus the question arises whether the Privy Council remained available. Records indicate not, and that successive Attorneys General had, as important players in Council and *scire facias* procedures, ended the Council's defeasance jurisdiction in favor of going to law. One indicator is the drop of petitions in 1782. But Petty Bag records also indicate that a transition occurred that year. 1782 marks the beginning of a series of *scire*

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112. E. Wyndham Hulme, *Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794*, 33 L.Q.R. 180, 184–93 (1917).

113. *Board of Ordnance* v. *Wilkinson*, PC2/123, pp. 529–30 (P.C. 1779); see also Hulme (n 112) 192.

114. *Grill* v. *Waters*, PC2/127, pp. 371–72 (P.C. 1782).

facias actions that extend well beyond 1800. The transition did not go unnoticed. The engineer, James Watt, wrote to a colleague in 1785, for instance, that *scire facias* "was revived by the present At[torney] General."[115] And Justice Buller noticed the development as well: "The proceeding by *scire facias*, to repeal a patent, is somewhat new in our days; none such has occurred within my memory ...."[116]

Additionally, if the Council had remained available at the end of the 18th century, one would have expected petitioners to use it instead of *scire facias*, which was a much more complicated and expensive procedure. In order to obtain the Attorney General's fiat, for example, prosecutors had to post a bond of £500 in which they promised to pay the patentee's costs should the action fail. And prosecutors bore all the expenses of *scire facias*, both in the Chancery and King's Bench, despite the action being brought in the name of the Crown and nominally for its benefit.[117] Importantly, a victorious prosecutor could not recover those expenses, as the Crown could not obtain costs at common law.[118]

It is true that in 1846 a treatise writer speculated that the Privy Council might still be avail-

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115. 3 Richard L. Hills, *James Watt* 194 (2006).

116. *Arkwright*, 1 Carp. P.C. at 77.

117. For the numerous steps and expenses associated with *scire facias* circa 1785, see John Palmer, *The Attorney and Agent's New Table of Costs* 175–81 (5th ed. 1796).

118. 3 Blackstone (n 20) 400; *Rex* v. *Miles*, 7 T.R. 367, 367 (K.B. 1797).

able in "extraordinary" circumstances,[119] but his contemporaries, when speaking of how to repeal or cancel a patent, spoke only of *scire facias*.[120]

CONCLUSION

On the validity issues discussed herein, English practice circa 1791 is clear. It is not "ambiguous."[121] After a patent issued, juries determined most validity questions, including the novelty of an invention. In keeping with the objective of this brief, *amici* take no position on the consequences of the foregoing historical narrative.

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119. Hindmarch (n 4) 431–32.

120. *E.g.*, Collier (n 66) 66–69, 176–81; William Hands, *The Law and Practice of Patents* 16–17 (1808); Godson (n 79) 147, 189–201; Holroyd (n 101) 183–88; William Carpmael, *The Law of Patents* 48, 50–52 (1832). That the defeasance clause remained as a vestigial appendage is not unusual. English patents also continued to state distinctly that their reach included the town of Berwick-upon-Tweed, long after that town had become part of England.

121. Lemley (n 2) 1735.